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| 10/507,406 | 04/08/2005 | Georg Frohlich | P04,0353 | 6881 |
| 26574 | 7590 | 09/08/2006 | EXAMINER MAI, THIEN T | |
| SCHIFF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473 | | | ART UNIT 2876 | |

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Acknowledgements

- Applicant's amendment filed on 06/09/2006 is hereby acknowledged. Claims 20, 35, 38, 41 are cancelled; claims 42-50 are newly added.

Inventorship Petition under CFR 1.48

In view of the papers filed 7/11/2006, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding inventor Robert Ahammer.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim(s) 18-19, 22-27, 31-37, 39-40, 20, 38, 42-50 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohberger (20030063139) in view of Pagnol (US 6,483,426). Hohberger discloses a method for production of a printed document in

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a form of a ticket, label, or tag with a unique identifier such as RFID, comprising the steps of: applying a RFID transponder as data medium 52 for said unique identifier on a recording medium such as label 14 during a document/label production event; so that data is written to the data medium 52 without contact at a distance (Specification par. 0009) through antenna emissions (Specification par. 52); a computer program for writing data onto the data medium as being done in block 160 (see Figure 7);

wherein the data in the RFID transponder is "encoded with relevant card member information from database 314" (Specification par. 0111), implying that the data programmed in the RFID and data of the card user/member are from the database 314, which by definition is a collection of data stored in a file.

Hohberger is silent with respect to the data medium comprising an unchangeable identifier number in an electronic region. Pagnol (6483426) discloses such concept is known when a plurality of transponders are involved in an identify operation of multiple transponders. (Fig. 1, Col. 1 lines 36-40, Col. 4 lines 50-53.) The transponder 1 of Pagnol comprises a storage memory area 13 (Fig. 2) where a unique serial number is written to (see Summary of Invention). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement the method of Pagnol for further improvement the security of the document that requires additional identification of the transponder.

Regarding claim(s) 19, Hohberger discloses the RFID is being verified and printed "void" if verification fails (Figure 7, 15).

Regarding claim(s) 22-23, Hohberger discloses card number with customer name 250 (Figure 18) printed on a Platinum card or post card (Specification par. 106, 111) as the identifier printed in plain text is also contained in the transponder.

Regarding claim(s) 24, Hohberger discloses a card member data base as a file are linked to the person carrying the card having id written on the card and in the transponder (Specification par. 0111).

Regarding claim(s) 25, see discussion regarding claim 19.

Regarding claim(s) 26, Hohberger discloses the data stored in the transponder being encoded (Specification par. 0009, 11, 35).

Regarding claim(s) 27, Hohberger discloses if the transponder is found defective or verification of the transponder fails, the document is separated out and the process continues as normal (Specification par. 61).

Regarding claim(s) 32-33, Hohberger discloses a printer and computer program being included in the system (claim 152).

Re claim(s) 42, Hohberger discloses in Specification par. 0008 of passive and active transponders that are capable of being written to (claim 52) inherently implies the transponders have a storage memory region.

3. Claim(s) 21, 28 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohberger (20030063139), as modified by Pagnol (6,483,426), further in view of Fredlund (20020181009) and Barrette (US 6,593,853)

Regarding claim(s) 21, Hohberger discloses all limitations set forth in this claim as discussed above except for the transponder is applied to the document before being

programmed. Fredlund discloses an electrophotographic printer embedded in a kiosk that makes postcards. The kiosk generates an identifier ID in step 102/202, which is stored in a barcode or rfid or magnetic strip, for the postcard, then receives user image and address information, sends information to the consumer and recipient, and then the post card is printed (figures 4-7, Specification par. 0047). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Fredlund's invention with the motivation for the desire to avoid wasting RFID tags with erroneous pre-programming.

Regarding claim(s) 28, Hohberger discloses all limitations set forth in this claim as discussed above except for the transponder is programmed after document has left printer. Barrette discloses an external programming module 18 placed adjacent to the printer to encode the RFID label as it is ejected from the printer (Abstract, figs 1-2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Barrette's teachings with the motivation for the desire to avoid programming the label on an erroneous or defective printed document.

4. Claim(s) 29-30 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohberger (20030063139), as modified by Pagnol (6,483,426), further in view of Kohut (US 6,343,241) and Grunes (US 6,816,075)

Regarding claim 29, Hohberger discloses all limitations set forth in this claim as discussed above except the information is stored in the data medium at the monitoring/detection point where the document is detected. Kohut discloses a gas station (Fig. 1) as the monitoring station detects the customer ID code from RFID tag

(Fig. 3) attached to a car and writes the transaction history to it each time the car comes to gas station for re-fueling (col. 8 lines 39-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Kohut's teaching by having a monitoring station such as of Kohut with the motivation for the desire for quality assurance checking by verification of the document for proper contents both printed on the document and written to the RFID.

Regarding claim(s) 30, Grunes discloses the information read from the RFID tag can be updated to the tag, a database, or both (col. 8 lines 50-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Grunes' teaching with the motivation for updating the database with other information found on the document, i.e. misprint and tampering.

Response to Amendment

5. Applicant's arguments have been fully considered and are considered unpersuasive.

In response to Applicants' argument with respect to claims 18 and 36 that Hohberger does not disclose "data written onto the data medium is linked to a file with data printed onto the printed document", it is respectfully submitted that information associated with a card member is printed on the card as seen in Figure 18 (numeral 250) and Figure 17 (member fields 206, 222, 226, par. 112, and other information regarding to a member class such as flight coupon for Gold and Platinum members). Further, the member information just mentioned are linked in a big file, known as

member database (designated as numeral 314 in Figure 19, par. 110-111). Thus, it is believed that the rejection remains valid.

In response to applicant's argument that reference Pagnol is nonanalogous art (i.e., "Pagnol has nothing to do with printed document ..." –page 10), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Hohberger is only deficient with respect to the identification being unchangeable. Pagnol is directed to detecting multiple cards, which can be interpreted as documents, by assigning each of which a unique serial number written in non-erasable memory 13 of each of them (Figure 2). By this token, it is believed that Pagnol mends the deficiency in Hohberger.

In response to Applicants' argument with respect to claims 19, 25, 27 that Hohberger does not disclose "the data on the document are compared with data of the file for identification of at least one of a person and goods", it is respectfully submitted that as shown in Figure 7, Hohberger teaches a step of verifying the information programmed in the RFID that contains information regarding a card member and if the programming was found to be improper, then the document is marked "void", which will then be discarded and/or reprogrammed. See also par. 0060+, 0081+, 0112+

6. In response to applicant's argument with respect to claim 29 that Kohut is nonanalogous art, it has been held that a prior art reference must either be in the field of

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applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Hohberger and/or Pagnol combined is deficient by only lacking the step of storing the information obtained when previously detected. The processing of a document, which is in the form of a card, in Kohut's teachings is similar in that previous transaction history that are detected is stored in the card to determine/track the number of times the document passes the monitoring station. Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

7. In response to Applicants' arguments with respect to claims 36-50, Applicant is respectfully directed to the above discussion that already address the issues mentioned in these arguments.

8. For the reasons stated above, the Examiner believes that a proper prima-facie case of obviousness has been established. Therefore, the rejection(s) is/are respectfully maintained.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien T. Mai whose telephone number is 571-272-8283. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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Thien T Mai

Examiner, Art Unit 2876

TM

A handwritten signature in cursive script, appearing to read 'T Mai', followed by a long horizontal line.A handwritten signature in cursive script, appearing to read 'AK', positioned above the printed name.

AHSHIK KIM
PRIMARY EXAMINER